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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,090	02/11/2004	Noriyoshi Kurotsu	03500.017893	1592
5514 7590 10/19/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER RODRIGUEZ, LENNIN R	
			ART UNIT 2625	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/775,090

Applicant(s)

KUROTSU ET AL.

Examiner

Lennin R. Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                    |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                               | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/18/2004</u> . | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

(1) page 12, line 12 "**400**".

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

(1) 606, 608 in Fig. 6;

(2) 1202, 1203, 1204, 1205, 1207, 1211, 1212, 1214, 1215, 1216 in Fig. 12;

(3) 1701, 1702, 1703, 1704, 1705 in Fig. 17.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities:

(1) page 7, line 20, "102 to **105**" should be – 102 to **104** --.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5, 11 and 17 recite the limitation "said second ID" in lines 3 and 8 in claims 5 and 11, and lines 3-4 and 8-9 in claim 17. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A "print control program" is being recited; however a "print control program" as presented in the claims is directed to software per se. This subject matter is not limited to that which falls within a statutory category of invention because it is limited to a process, machine, manufacture, or a composition of matter. Software is a function descriptive material and a function descriptive material is non-statutory subject matter.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatsuma et al. (US Patent 6,115,132) in view of Petchenkine et al. (US Patent 6,380,951).

(1) regarding claims 1, 7 and 13:

Nakatsuma '132 discloses an information processing apparatus (102 in Fig. 1) for exerting print control (column 5, lines 28-31), comprising:

a spooling unit (801 in Fig. 9), adapted for again spooling print data created and spooled via a print data creation module (column 12, lines 1-28, where data already spooled is stored in a virtual spooler); and

a control unit (202 in Fig. 2), adapted for performing the spooling of the print data by said spooling unit and output of the print data to a resending destination or an alternate device (column 14, lines 1-5, where the control unit is performing the spooling the data and sending it to a network printer).

Nakatsuma '132 discloses all the subject matter as described above except performing the spooling and outputting the print data concurrently.

However, Petchenkine '951 teaches performing the spooling and outputting the print data concurrently (column 3, lines 24-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to performing the spooling and outputting the print data concurrently as taught by Petchenkine '951, in the system of Nakatsuma '132. With this operators can spool/print directly to the hard drive, freeing the workstation quickly (column 3, lines 23-24).

(2) regarding claims 2, 8 and 14:

Nakatsuma '132 further discloses an ID creation unit, adapted for creating a first ID issued correspondingly to the print data created via the print data creation module (column 13, lines 20-43) and a second ID to the print data spooled by said spooling unit

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apart from said first ID (column 16, lines 50-58 and column 24, lines 36-39, where an ID different from the first one its being created); and

a management unit (710 in Fig. 7), adapted for performing job management corresponding to the second ID created by said ID creation unit columns 16-17, lines 58-67 and 1-7 respectively).

(3) regarding claims 3, 9, and 15:

Nakatsuma '132 further discloses wherein the first ID is an ID issued via an OS (column 6, lines 59-67 and column 13, lines 20-23, where the job ID its being obtained from the virtual print server service which the OS is controlling).

(4) regarding claims 4, 10, and 16:

Nakatsuma '132 further discloses wherein, on alternation or resending of said print data, said control unit continues the spooling of the data already spooled before the alternation or resending (column 2, lines 20-23, and column 29, lines 41-46).

(5) regarding claims 5, 11 and 17:

Nakatsuma '132 further discloses a notification unit (712 in Fig. 7), adapted for notifying said second ID to an alternation destination printer specified of a plurality of printers via an alternate setting screen (Fig. 32, column 35, claim 17, plurality of printers and column 13, lines 52-62);

an identification unit, adapted for identifying the print data to be alternated based on said second ID notified by said notification unit (column 16, lines 55-63, where the job ID is identified); and

a reading unit (712 in Fig. 7), adapted for reading the print data identified by said identification unit (column 13, lines 56-58),

wherein said control unit concurrently performs the spooling of the print data by said spooling unit and the reading by said reading unit (column 14, lines 1-5, where the data its being read and spooled by the control unit (202 in Fig. 2)).

(6) regarding claims 6, 12 and 18:

Nakatsuma '132 further discloses wherein each of said plurality of printers has port information set up correspondingly (Fig. 34).

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-3, 7, 13-15 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 11-14 of copending Application



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No. 10/774473. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-3 in the present application are directed towards spooling print data created and spooled via a print data creation module, where as claims 1-3 of the referenced copending application are directed towards print data spooled by an operating system. It appears to the examiner that these limitations (creation module in view of operating system) are obvious variations of each other since a creation module could reasonably be an operating system.

For example regarding claim 1 with regards to application 10/774473:

A print control program executed by an information processing apparatus (claim 1, lines 1-2, comprising:

a spooling step of spooling print data created and spooled via a print data creation module again (claim 1, lines 5-8); and

a control step of concurrently performing the spooling of the print data of said spooling step and output of the print data to a resending destination or an alternate device (claim 1, lines 9-13).

The difference between '473 and the present application is that the system is having print data spooled by an operating system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of '473 application as a general teaching for a print control program to perform the same functions as claimed by the present application and do it with an operating system because it would be more efficient for the system to do it that way.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stuart (US Patent 6,466,935) discloses the JES Assigned 333 ID represents a text string specifying the ID assigned by the Job Entry System or Print Manager when print jobs are submitted for spooling (i.e., to correlate release/hold and cancel requests mail job print by the print job spooler).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lennin R. Rodriguez whose telephone number is (571) 270-1678. The examiner can normally be reached on Monday - Thursday 7:30am - 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lennin Rodriguez  
10/16/07



KING Y. POON  
SUPERVISORY PATENT EXAMINER